PATENT

Application No. 09/668,213
Atty. Dkt. No. A-68940-5/JAS

REMARKS

This is intended as a full and complete response to the Office Action dated May 21, 2003, having a shortened statutory period for response set to expire on August 21, 2003. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1 - 26 remain pending in the application and are shown above. Claims 5, 6, 12 and 17 stand withdrawn by the Examiner. Claims 1 - 4, 7 - 11, 13 - 16 and 18 - 26 are rejected by the Examiner. Claims 1, 7, 8 and 13 are amended by this Response. Reconsideration of the rejected claims is requested for reasons presented below.

Claims 1, 7 and 13 are amended to correct matters of form. These amendments are not presented to distinguish a reference, thus, the claims as amended are entitled to a full range of equivalents if not previously amended to distinguish a reference.

Claims 1 - 4 stand rejected under 35 USC § 102(e) in view of U.S. Patent Number 6,422,462B1 to Cohen. Applicants respectfully traverse the rejection. The Examiner asserts that, regarding claim 1,

> Cohen discloses a method for pushing a transaction request from an remote electronic transaction system running an Agent to a portable electronic authorization device carried by a user for an electronic confirmation, comprising the steps of pushing a transaction request from Agent running at said an remote electronic transaction system triggered by a pre-determined event; receiving at the portable electronic authorization device first digital data representing the transaction request; providing information to the user regarding an ability to approve or modify the transaction request; and when the transaction request is approved by the user, receiving at the electronic transaction system second digital data representing the electronic confirmation of the transaction request; and wherein the receiving step is performed via a wireless communication port associated with the portable electronic authorization device. (Col 1 ln 45 – col 2 ln 23).

Embodiments according to the present invention relate to portable electronic authorization devices (PEADs) that substantially eliminate security risks associated with prior techniques of approving transactions between a user and an electronic transaction system. The reference Cohen does not teach the elements of claim 1 as asserted by the Examiner. For example, claim 1 recites in part "pushing a transaction request from the xAgent running at a remote electronic transaction system triggered by a pre-determined event." No such teaching is found in Cohen.

In contrast, the cited portion of Cohen generally teaches at a high level improved credit cards and methods providing for customization, limited use, single use (disposability) and secure transmission of credit card information.

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Cohen does not disclose how to push a transaction request to a portable electronic authorization device upon the occurrence of a predetermined event. Therefore, Cohen does not teach the elements of the present invention as recited in claim 1 and claims dependent thereon. Withdrawal of the rejection is respectfully requested.

Applicants further traverse the rejection of dependent claims 2 – 6 on grounds that they depend from independent claim 1. Withdrawal of the rejection is respectfully requested.

Claims 7 - 11 stand rejected under 35 USC § 102(e) in view of U.S. Patent Number 6,422,462B1 to Cohen. Applicants respectfully traverse the rejection. The Examiner asserts that, regarding claim 7,

> Cohen discloses a portable electronic authorization device for approving a transaction request from a point-of-sale system, comprising a transceiver in the portable electronic authorization device configured to receive first digital data representing the transaction request; a display configured to provide information to the user regarding an ability to approve or modify the transaction request; and a scanner configured to scan at least one of bar-code or OCR information; wherein the transceiver is further configured such that when the transaction request is approved by the user, the transceiver is configured to transmit second digital data representing the electronic confirmation of the transaction request. (Col 1 ln 45 – col 2 ln 23).

The reference Cohen does not teach the elements of amended claim 7 as asserted by the Examiner. For example, amended claim 7 now recites in part "a downloadable transaction program to enable the portable electronic authorization device to perform a transaction." Support for this amendment appears on pages 21 and 22 of the present application as filed. In one embodiment, the transaction program is essentially a program or an applet that is downloaded into a requesting device from a server and executed at the requesting device to carry out an electronic transaction. No such teaching is found in Cohen.

Therefore, Cohen does not teach the elements of the present invention as recited in amended claim 7 and claims dependent thereon. Withdrawal of the rejection is respectfully requested.

Applicants further traverse the rejection of dependent claims 8 – 11 on grounds that they depend from independent claim 7. Regarding claim 8, the recitation that "a scanner is configured to scan in the barcode information to establish the communications link between the portable electronic authorization device and a Point-of-Sale terminal" is not found in Cohen. Withdrawal of the rejection is respectfully requested.

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Claims 13 - 16 stand rejected under 35 USC § 102(e) in view of U.S. Patent Number 6,422,462B1 to Cohen. Applicants respectfully traverse the rejection. The Examiner asserts that, regarding claim 13,

> Cohen discloses a method for xAgent automatic ordering from a remote merchant server using a portable electronic authorization device carried by a user, comprising the steps of entering product information at the portable electronic authorization device; accumulating the product information by tan xAgent running on the portable electronic authorization device; triggering xAgent automatic ordering upon user pre-defined event;
> receiving at the portable electronic authorization device a first digital data representing the transaction request; providing information to the user regarding an ability to approve the transaction request; when the transaction request is approved by the user, encrypting transaction approval data as second digital data representing approval by the user to purchase the item; and transmitting the second digital data to the electronic transaction system to approve the transaction request with the electronic transaction system. (Col 1 ln 45 – col 2 ln 23).

Therefore, the reference Cohen does not teach the elements of the present invention as recited in claim 13 and claims dependent thereon. For example, claim 13 teaches xAgent automatic ordering from a remote merchant server using a portable electronic authorization device . . . triggering xAgent automatic ordering upon user pre-defined event. No such teaching is found in Cohen. Withdrawal of the rejection is respectfully requested.

Applicants further traverse the rejection of dependent claims 14 – 16 on grounds that they depend from independent claim 13. Withdrawal of the rejection is respectfully requested.

Claims 18 - 26 stand rejected under 35 USC § 102(e) in view of U.S. Patent Number 6,422,462B1 to Cohen. Applicants respectfully traverse the rejection. The Examiner asserts that, regarding claim 18,
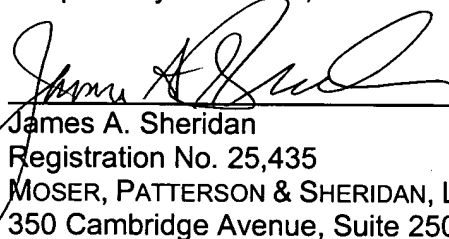
> A method for self-checkout between an electronic point of sale transaction system and a portable electronic authorization device carried by a user, comprising the steps of entering product information at the portable electronic authorization device; establishing communication link between the electronic point of sale transaction terminal and the portable electronic authorization device; receiving at the portable electronic authorization device a first digital data representing the transaction request; providing information to the user regarding an ability to approve the transaction request; when the transaction request is approved by the user, encrypting transaction approval data as second digital data representing approval by the user to purchase the item; and transmitting the second digital data to the electronic transaction system to approve the transaction request with the electronic transaction system; and printing a receipt at a remote printer. (Col 1 ln 45 – col 2 ln 23).

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Therefore, the reference Cohen does not teach the elements of the present invention as recited in claim 18 and claims dependent thereon. For example, encrypting the approval data using a public key cryptography technique using at least a user's private key is not taught in Cohen. Withdrawal of the rejection is respectfully requested.

Applicants further traverse the rejection of dependent claims 19 – 26 on grounds that they depend from independent claim 19. Withdrawal of the rejection is respectfully requested.

In conclusion, the reference cited by the Examiner does not teach the invention as claimed. Having addressed all issues set out in the office action, Applicant respectfully submits that the claims are in condition for allowance and respectfully requests that the claims be allowed.

Respectfully submitted,

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